

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN H. NEWTON, R. MICHAEL McGRADY and
R. BARRIE SLAYMAKER JR.

Appeal 2006-3170
Application 09/428,036
Technology Center 3600

Decided: September 19, 2007

Before WILLIAM F. PATE, III, TERRY J. OWENS, and
HUBERT C. LORIN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal from a rejection of claims 1-45, which are all of the pending claims.

THE INVENTION

The Appellants' claimed invention relates to methods for dispensing and tracking an inventory of medical items used to treat patients in a health care setting (Spec. 1:3-5). Claim 1 is illustrative:

1. A method comprising the steps of
 - (a) storing in at least one data store in operative connection with at least one computer, data representative of at least one patient and at least one medical item prescribed for use by the patient;
 - (b) storing in the data store, data representative of a plurality of holding locations for medical items in a medical item dispenser, a plurality of types of medical items, and for each of the storage locations, a type medical item stored in the respective storage location;
 - (c) inputting through an input device in operative connection with the computer and the dispenser, data corresponding to the patient;
 - (d) dispensing from the dispenser responsive to the data stored in the data store, the type medical item prescribed for use by the patient, wherein the type medical item is dispensed from a storage location holding the type medical item in the dispenser;
 - (e) including in the data store responsive to execution of step (d), data representative that the type medical item has been dispensed for use by the patient, and that the type medical item has been dispensed from the dispenser.

THE REFERENCES

Kaufman	US 5,036,462	Jul. 30, 1991
Cummings	US 5,301,105	Apr. 5, 1994
Kraft	US 5,502,944	Apr. 2, 1996
Liff	US 5,797,515	Aug. 25, 1998

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THE REJECTIONS

The claims stand rejected as follows: claims 1, 10-23, 26 and 27 under 35 U.S.C. § 102(e) as anticipated by Kraft; claims 24 and 25 under 35 U.S.C. § 103 as obvious over Kraft; claims 2-9 under 35 U.S.C. § 103 as obvious over Kraft in view of Liff; claims 28-31, 34-39 and 42-44 under 35 U.S.C. § 103 as obvious over Kraft in view of Kaufman; and claims 32, 33, 40, 41 and 45 under 35 U.S.C. § 103 as obvious over Kraft in view of Kaufman and Cummings.

OPINION

The rejection of claims 1, 10-23, 26 and 27 under 35 U.S.C. § 102(e) over Kraft is affirmed as to claims 1 and 23, and reversed as to claims 10-22, 26 and 27. The rejection of claims 24 and 25 under 35 U.S.C. § 103 over Kraft is affirmed. The rejection of claims 2-9 under 35 U.S.C. § 103 over Kraft in view of Liff is affirmed. The rejection of claims 28-31, 34-39 and 42-44 under 35 U.S.C. § 103 over Kraft in view of Kaufman is affirmed as to claim 28, 34-39 and 42-44, and reversed as to claims 29-31. The rejection of claims 32, 33, 40, 41 and 45 under 35 U.S.C. § 103 over Kraft in view of Kaufman and Cummings is affirmed as to claim 45, and reversed as to claims 32, 33, 40 and 41. The application is remanded to the Examiner.

Rejection of claims 1, 10-23, 26 and 27
under 35 U.S.C. § 102(e) over Kraft

Claims 1 and 23

Kraft discloses “a medical dispenser system to provide medications to nurses in a hospital setting” (col. 1, ll. 7-8). Patients’ medical requirements are stored on a pharmacy system (14) which is accessible by a medical dispenser (12) through a network (16) (col. 4, ll. 56-59). The medical dispenser’s network functions are performed by a system controller (34) (col. 4, ll. 59-60). A nurse enters into the network an order for medication for one or more patients, and then the medical dispenser retrieves each medication from its respective container and dispenses the medication to a medication packaging subsystem (38) which packages the medication into individual medication units which are labeled with information including the medication and dose size, the patient’s name and room number, and the doctor’s name (col. 4, l. 60 – col. 5, l. 7; col. 5, ll. 21-46). “As individual medication is dispensed, the system controller **34** records the information” (col. 5, ll. 6-7).

In operation, the system controller **34** acts as the interface between the medication dispenser **12** and the operators, such as nurses and pharmacy personnel. Responsive to an operator input, the system controller retrieves information through the network **16** regarding patient medication records and sends information to the control electronics **36**. Responsive to the information from the system controller **34**, the control electronics interfaces with the various subsystems **38-44** to dispense the requested medications.

The system controller **34** also communicates accounting information so that the patients are accurately billed. As medications are dispensed, the information on the quantity and type of medication dispensed for each patient is communicated to the pharmacy system

(or other accounting system). Also, the information regarding the time of dispensing and the type and quantity of medication can be used to ensure that the medication was properly administered. [col. 5, ll. 38-55]

* * *

The system controller **34** can also be used to output reports specific to the dispenser **12**, such as a list of the inventory in the dispenser. [col. 5, ll. 63-65]

* * *

As medication is dispensed, the database is updated to reflect the remaining number of the medication units in the container. [col. 6, ll. 31-33]

The Appellants argue that Kraft does not store, responsive to the medication dispensing, data representative that the medical item actually has been dispensed (Br. 13).¹ Kraft, the Appellants argue, uses “is dispensed” and “are dispensed”, whereas the Appellants’ claim 1 uses “has been dispensed” (Br. 14-15). The Appellants argue that Kraft does not check or know whether an item was in fact dispensed (Br. 13, 15). The Appellants’ claim 1 requires data representative that the medical item has been dispensed from the dispenser. Kraft’s information on the type and quantity of medication, communicated to the pharmacy system for accurate billing to the patient (col. 5, ll. 47-55), and Kraft’s database update to reflect the remaining number of medication units in the container (col. 6, ll. 31-34), are at least representative that the medical item has been dispensed from the

¹ Citations herein to the Brief are to the Supplemental Appeal Brief filed April 15, 2004. Our discussion of the arguments in the Brief applies to the similar arguments in the Reply Brief.

dispenser, i.e., they at least present to the mind or put clearly before the mind the actual dispensing.²

We therefore are not convinced of reversible error in the rejection of claims 1 and 23.

Claims 10-15

Claim 10, which depends from claim 1, requires, prior to step (d), displaying on an output device adjacent to the dispenser, indicia including indicia indicative of the type medical item.

The Examiner argues that the requirement in claim 10 “is met by the video display (26, Fig. 2) and printer (30, Fig. 2) connected to the medication dispenser (see: column 4, lines 3-15 and Fig. 2)” (Ans. 5). Neither Kraft’s figure 2 nor column 4, lines 3-15 discloses displaying indicia indicative of the type medical item.

The Examiner, therefore, has not established a *prima facie* case of anticipation of the inventions claimed in the Appellants’ claim 10 or its dependent claims 11-15.

Claims 16-22

Claim 16, which depends from claim 1, requires inputting through a physician terminal prescription data representative that the medical item has been prescribed for the patient.

² See Webster’s New World Dictionary of the American Language 1235 (World Publishing 1966).

The Examiner argues that Kraft discloses that the patients' medical requirements are stored in the pharmacy system and that the nurse enters commands through the system controller (Ans. 6). The Examiner, however, does not point out where Kraft discloses inputting prescription data through a physician terminal.

Hence, the examiner has not established a *prima facie* case of anticipation of the inventions claimed in the Appellants' claim 16 or its dependent claims 17-22.

Claims 26 and 27

Claim 26, which depends from claim 1, requires checking the data store representative of a patient's medical history and determining responsive to the medical history data if a medical item should be withheld from the patient.

The Examiner argues that Kraft's comparison of a medication package's label with the specified medication to verify that the correct medication is being dispensed (col. 7, ll. 32-34) includes checking data representative of the patient's medical history (Ans. 8). The portion of Kraft relied upon by the Examiner merely discloses checking that the medication desired to be dispensed is being dispensed. It does not disclose checking whether, based upon the patient's medical history, the medication should be withheld from the patient.

Thus, the Examiner has not established a *prima facie* case of anticipation of the inventions claimed in the Appellants' claim 26 or its dependent claim 27.

Rejection of claims 24 and 25
under 35 U.S.C. § 103 over Kraft

The Appellants argue that Kraft fails to disclose contacting a patient regarding input patient data or contacting a physician if the medical item is not dispensed (Br. 29). Given Kraft's disclosures of inputting patient data and, in response thereto, dispensing medication (col. 4, ll. 56-66), one of ordinary skill in the art, through no more than ordinary creativity, would have contacted the patient when the data being input was questionable and would have contacted the physician if there were a question about whether the medication is correct for the patient. *See KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton”).

Hence, we are not persuaded of reversible error in the rejection of claims 24 and 25.

Rejection of claims 2-9 under 35 U.S.C. § 103
over Kraft in view of Liff

Liff discloses an apparatus and method for automated dispensing of pharmaceuticals (col. 2, ll. 8-10). The portions of Liff relied upon by the Examiner (Ans. 10) disclose using electronic third-party payor cards to pay for a drug purchase at a doctor's office (col. 4, l. 67 – col. 5, l. 2), and automatically verifying a patient's insurance information to determine whether an insurer will pay for the drug purchase (adjudication 286, col. 13, ll. 12-42; col. 16, ll. 40-52).

The Appellants argue that Liff is not prior art because the Appellants have priority in US 5,790,409 to Fedor et al. before Liff's filing date as to elements (a)-(e) in claim 1 (Br. 21). The Appellants argue, in reliance upon MPEP § 715.02, that Fedor et al. carries with it possession of obvious variations and adaptations, so, if the subject matter in claims 2-9 would have been obvious to one of ordinary skill in the art, it is covered by Fedor et al. (Br. 21-22). As set forth in MPEP § 715.02, the Appellants must provide evidence that the subject matter of claims 2-9 would have been obvious to one of ordinary skill in the art over the relied-upon disclosures in Fedor et al., and the Appellants have not done so. Moreover, if the subject matter of claims 2-9 would have been an obvious variant of the relied-upon disclosures in Fedor et al., then it likewise would have been an obvious variant of Kraft, and Liff would not be needed.

Claims 2 and 4

The Appellants ask, “[w]here does Liff even mention a benefit plan?” (Br. 23), and argue that Kraft and Liff do not disclose a benefit provider (Br. 26-27). Liff’s disclosures of a third-party payor card and patient insurance (col. 4, l. 67 – col. 5, l. 1; col. 13, ll. 26-30) at least would have rendered an insurance benefit plan and provider obvious to one of ordinary skill in the art.

Claims 3

The Appellants argue that Kraft and Liff fail to teach or suggest a debit or credit card reading device adjacent to a medical item dispenser (Br. 25-26). Kraft, the Appellants argue, requires a secure hospital nursing

station and, therefore, teaches away from dispensing a medical item to a patient. *See id.*³ As stated by the Supreme Court in *KSR*, in making an obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Liff’s disclosure of using a third-party payor card for drug purchases (col. 4, l. 67 – col. 5, l. 1) would have led one of ordinary skill in the art, through no more than ordinary creativity, to have the nurse swipe the card at any convenient location such as the medical item dispenser.

Claims 5-8

The Appellants argue that Kraft and Liff fail to teach or suggest a co-pay amount (Br. 27-28). Liff’s disclosures of a third-party payor card and patient insurance (col. 4, l. 67 – col. 5, l. 1; col. 13, ll. 26-30) at least would have rendered an insurance benefit plan with co-pay obvious to one of ordinary skill in the art.

We therefore are not persuaded of reversible error in the rejection of claims 2-8 and claim 9 which depends from claim 1 and is not separately argued.

³ The Appellants do not point out where Kraft requires that the nursing station is secure.

Rejection of claims 28-31, 34-39 and 42-44 under
35 U.S.C. § 103 over Kraft in view of Kaufman

Kaufman discloses a medication dispensing system that receives input from a physician or other health care professional, the patient, physical testing devices and environmental sensors (col. 1, ll. 8-9; col. 8, ll. 15-23). The system “can be used in virtually any environment where storage and delivery of selective medications are desired, such as in a hospital, nursing home, or pharmacy” (col. 19, ll. 57-60).

Claims 28, 34-39 and 42-44

The Appellants argue that Kraft discloses a secured hospital dispenser (Br. 30, 33), apparently implying that the dispenser must not be accessible by the patient, but the Appellants do not point out where such a disclosure appears in Kraft. Kraft’s disclosure of requiring nurse identification for dispenser access (col. 5, ll. 8-10) does not exclude patient access to the dispenser using patient identification. The Appellants argue that Kraft’s dispenser is at a nursing station intentionally located away from a patients room (Br. 33), but the Appellants do not point out where Kraft discloses that the patient cannot leave the room to go to the dispenser. Kaufman’s disclosure of a medication dispenser useful in virtually any environment where storage and delivery of selective medications are desired, including a patient’s home and a hospital (col. 1, ll. 9-14; col. 19, ll. 57-60), would have led one of ordinary skill in the art, through no more than ordinary creativity, to enable Kraft’s medication dispenser to provide the benefit of access at the nursing station to both the nurse and the patient. That would involve a

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modification of Kraft's system, not a replacement of Kraft's system by Kaufman's system as argued by the Appellants (Br. 34-35). The modified system would be accessible by patients generally, not just one patient as argued by the Appellants (Br. 37-38). Displaying the payment amount to each patient (Appellants' claim 42) would have been obvious to one of ordinary skill in the art to inform the patient as to the cost of the medication being dispensed. One of ordinary skill in the art, through no more than ordinary creativity, would have verified that a requested medical item has been dispensed (Appellants' claims 34 and 44) to ensure that the patient receives the requested medication.

We therefore are not convinced of reversible error in the rejection of claims 28, 34-39 and 42-44.

Claims 29-31

Claim 29 depends from claim 2, and claims 30 and 31 depend directly or indirectly from claim 29. For a suggestion of the benefit plan required by claim 2 the Examiner relies upon Liff (Ans. 10). Liff, however, is not applied to claim 29, and the Examiner does not explain how the references applied to claim 29 (Kraft and Kaufman) would have rendered obvious a benefit plan to one of ordinary skill in the art (Ans. 16).

The Examiner, therefore, has not established a *prima facie* case of obviousness of the inventions claimed in the Appellants' claims 29-31.

Rejection of claims 32, 33, 40, 41 and 45 under 35 U.S.C. § 103
over Kraft in view of Kaufman and Cummings

Cummings discloses a fully integrated health care system comprising a terminal having a slot for swiping a card (col. 2, ll. 5-21; col. 7, ll. 25-31).

Claims 32 and 33

Claims 32 and 33 depend indirectly from claim 29, and the Examiner does not rely upon Cummings for a disclosure of a benefit plan. Hence, for the reason given above regarding claim 29, the Examiner has not established a *prima facie* case of obviousness of the inventions claimed in the Appellants' claims 32 and 33.

Claims 40 and 41

The Examiner argues that claims 40 and 41 are rejected for the same reasons as claims 33 and 32, respectively (Ans. 25). For the reasons given above regarding those claims, the Examiner has not established a *prima facie* case of obviousness of the inventions claimed in claims 40 and 41.

Claim 45

The Appellants argue that Cummings is nonanalogous art (Br. 44). The test of whether a reference is from an analogous art is first, whether it is within the field of the inventor's endeavor, and second, if it is not, whether it is reasonably pertinent to the particular problem with which the inventor was involved. *See In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's

attention in considering the inventor's problem. *See In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). The Supreme Court's statement in *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007) that “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one” indicates that for prior art to be properly applied in a rejection it need not satisfy the first prong of the nonanalogous art test. The Supreme Court also stated in *KSR* that “the problem motivating the patentee may be only one of many addressed by the patent's subject matter. The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art.” *KSR*, 127 S.Ct. at 1742, 82 USPQ2d at 1397. Those statements indicate that for prior art to be properly applied in a rejection it need not satisfy the second prong of the nonanalogous art test. Hence, the Appellants' argument that Cummings is nonanalogous art is not well taken. Regardless, Cummings is analogous art because it is in the field of health care systems and is reasonably pertinent to the Appellants' problem of dispensing and paying for medications.

The Appellants argue that Cummings's card data entry slot is not associated with a medical item dispenser (Br. 44-45). One of ordinary skill in the art would have been led by Kraft's disclosure of paying for the dispensed medical items (col. 5, ll. 47-55) to enable payment of the items using a ubiquitous device such as a credit card, swiped at any convenient location such as the point at which the medication item is dispensed. The

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other limitations in claim 45 appear in claims previously discussed and, for the reasons given regarding those claims, would have been rendered prima facie obvious to one of ordinary skill in the art by the applied prior art.

Hence, we are not convinced of reversible error in the rejection of claim 45.

Remand

The application is remanded to the Examiner to address whether the inventions claimed in the Appellants claims 10-22, 26 and 27 would have been prima facie obvious to one of ordinary skill in the art over Kraft, alone or in combination with other prior art, and whether the inventions claimed in the Appellants' claims 29-33, 40 and 41 would have been prima facie obvious to one of ordinary skill in the art over the prior art applied to those claims combined with Liff.

DECISION

The rejection of claims 1, 10-23, 26 and 27 under 35 U.S.C. § 102(e) over Kraft is affirmed as to claims 1 and 23, and reversed as to claims 10-22, 26 and 27. The rejection of claims 24 and 25 under 35 U.S.C. § 103 over Kraft is affirmed. The rejection of claims 2-9 under 35 U.S.C. § 103 over Kraft in view of Liff is affirmed. The rejection of claims 28-31, 34-39 and 42-44 under 35 U.S.C. § 103 over Kraft in view of Kaufman is affirmed as to claim 28, 34-39 and 42-44, and reversed as to claims 29-31. The rejection of claims 32, 33, 40, 41 and 45 under 35 U.S.C. § 103 over Kraft in view of Kaufman and Cummings is reversed as to claims 32, 33, 40 and

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41, and affirmed as to claim 45. The application is remanded to the Examiner.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 41.50(e) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) provides that

[w]henever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

Regarding any affirmed rejection, 37 CFR § 41.52(a)(1) provides

"[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

The effective date of the affirmation is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART and REMANDED

vsh

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